

REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

Status of the Claims

Claims 3-9, 12-13, and 15-27 will be pending in the application upon entry of the present amendment. Claim 23 has been amended by incorporating the subject matter of claim 14. As such, claim 14 has been cancelled herein. Claims 5 and 12 have also been amended. Claims 25-27 have been added. Support for new claims 25-27 can be found in claims 4 and 6-8. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Claim Objections

The Examiner has objected to claim 5 for reciting “on” instead of “or.” This portion of claim 5 has been deleted, which renders the objection moot. As such, Applicants respectfully request that the objection be removed.

Issues under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 3, 5, and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse in view of the amended claims.

Claims 5 and 12 have been amended in order to overcome the outstanding rejection. Accordingly, Applicants respectfully request that the rejection be removed.

Issues under 35 U.S.C. § 102

1) Claims 15, 22, and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by McIntosh, Jr. et al. ‘209 (US 4,908,209).

2) Claims 23, 24, 3-5, 9, 12-17, and 20-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ohnishi et al. ‘508 (US 6,524,508).

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Present Invention and its Advantages

As discussed on page 1 of the present specification, information carriers recited in amended claim 23 are very commonly handled information, and as such, they are vehicles for illness contamination.

The present invention provides an information carrier such as a banknote, a passport, a playing card, a chipcard, a packaging, a book, or a magazine with a bactericidal (or bacteriostatic) agent and a fungicidal (or fungistatic) agent in order to prevent epidemic or pandemic illnesses. Today, with flu increasing, such prevention is essential for frequently used carriers. This issue was not considered previously.

Advantageously, the combination according to the present invention of an agent having a bactericidal action with another agent having a fungicidal action has proven to be very effective as described in Examples 15-20 and illustrated in Table 2. These combinations are particularly effective in terms of preventing bactericidal and fungicidal development when compared to the use of only one biocidal agent having both bactericidal and fungicidal action. Moreover, the range of bacteria and fungi for which development has been stopped is also increased.

Distinctions over McIntosh, Jr. et al. '209

As amended, claim 23 incorporates the subject matter of claim 14, which was not included in this rejection. As such, McIntosh, Jr. et al. '209 fail to disclose each and every element of independent claim 23 as well as those claims dependent thereon.

Specifically, McIntosh, Jr. et al. '209 disclose one biocidal compound combined with a carrier such as a house paint or a canvas for outdoor activities (col. 3, lines 45-61). Such carriers are not an information carrier such as a banknote or a passport as claimed by the present invention. In house paint or a canvas for outdoor activities, the problem of contamination by multiple handlings is not present. Therefore, one of ordinary skill in the art would not have relied on McIntosh, Jr. et al. '209 to find a solution to prevent epidemic or pandemic illnesses for frequently handled items.

Additionally, McIntosh, Jr. et al. '209 disclose the use of a biocidal agent rather than two special biocidal agents, namely a first biocide being a bactericidal (or a bacteriostatic) agent and a second biocide being a fungicidal (or a fungistatic) agent in order to obtain the effectiveness and range protection of the claimed invention.

Accordingly, the present invention is not anticipated by McIntosh, Jr. et al. '209 since the reference does not teach or provide for each of the limitations recited in the pending claims.

For completeness, Applicants also respectfully submit that McIntosh, Jr. et al. '209 do not render the present invention obvious because neither the reference nor the knowledge in the art provides any disclosure, reason, or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed.

Distinctions over Ohnishi et al. '508

Ohnishi et al. '508 disclose chitosan combined with acrylic fibers for cloths (col. 6, lines 48-51). Ohnishi et al. '508 fail to disclose a frequently handled information carrier such as a banknote or a passport as claimed by the present invention. Ohnishi et al. '508 do not disclose the use of an agent to prevent epidemic or pandemic illnesses caused by frequently handled items.

Additionally, Ohnishi et al. '508 do not disclose the use of a first biocide being a bactericidal agent and a second biocide being a fungicidal agent. Therefore, Ohnishi et al. '508 do not achieve the effectiveness or range protection of the claimed information carrier.

Accordingly, the present invention is not anticipated by Ohnishi et al. '508 since the reference does not teach or provide for each of the limitations recited in the pending claims.

Issues under 35 U.S.C. § 103(a)

1) Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohnishi et al. '508 in view of Phan et al. '339 (US 5,039,339).

2) Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohnishi et al. '508 in view of Widra '629 (US 4,570,629).

3) Claims 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohnishi et al. '508.

Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

Distinctions over the Cited References

As discussed above, Ohnishi et al. '508 do not disclose each and every aspect of claim 23, from which all other pending claims ultimately depend. Applicants respectfully submit that Phan et al. '339 and Widra '629 do not overcome the deficiencies of this reference.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Ohnishi et al. '508, with or without the other cited references, fail to disclose all of the claim limitations of independent claim 23, and those claims dependent thereon. Accordingly, the combination of references does not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

New Claims 25-27

Applicants have newly added claims 25-27 in an effort to further define the scope of protection owed to Applicants. Applicants respectfully submit that claims 25-27 are allowable for the reasons given above. As such, Applicants respectfully assert that claims 25-27 clearly define over the cited references, and an early action to this effect is earnestly solicited.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 3-9, 12-13, and 15-27 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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